

## REMARKS

### **I. INTRODUCTION**

Claims 2 to 17 are pending. Reconsideration of the present application is respectfully requested.

### **II. REJECTION OF CLAIMS 2 , 5-9, 13 AND 17 UNDER 35 U.S.C. § 102(e)**

Claims 2, 5 to 9, 13 and 17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pub. No. 20030176937 to Janky et al. ("Janky").

Claim 17 relates to a device for playing back multimedia files stored in an automotive environment, which includes, inter alia, a storage device and a processor for decoding the multimedia files. Claim 17 recites that the processor includes an element for displaying directories located in the storage device and in which the multimedia data files are contained, as different data carriers, and the multimedia data files as different titles on the display, and the different data carriers and the different titles are selectable in accordance with an operation of the input apparatus.

Janky purports to relate to the delivery of compressed digitized text or audio data for conversion to speech, in which the digitalized text/audio data is downloaded to a personal computer ("PC") 51 or to a portable storage and playback unit ("SPU") 81 that store and play back the digitized text or audio data. See Janky, paragraph [0001] and Abstract. The PC 51 includes a hard drive 57, floppy drive 59, RAM 63, ROM 61 and audible/visual display 67. See Janky, paragraph [0028] and FIG. 1. The SPU 81 includes a hard drive 93, flash memory 92, RAM 91, ROM 89 and display 97. See Janky, paragraph [0033] and FIG. 2. In this regard, it is respectfully submitted that the display module 67 and display 97 do not display directories located in any memory/storage device of the PC 51 or the SPU 81 as different data carriers, as required to anticipate the features of claim 17. Indeed, Janky does not discuss a display of directories, or even the existence of a directory structure. Moreover, Janky makes no mention of the display of multimedia data files as titles, or the storage of multimedia data files in an automotive environment, as recited in claim 17. Hence, the reference relied upon does not identically describe (or even suggest) the features of claim 17 — as it must to support an anticipation rejection. It is therefore respectfully submitted that claim 17, as well as any claims that depend from claim 17, including claims 6 to 8, 13 and 14, and claims 2 and 5 which recite features essentially analogous to claim 17, are allowable over the reference relied upon.

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

In view of the foregoing, withdrawal of the anticipation rejections is respectfully requested.

### **III. REJECTION OF CLAIMS 3, 4, 10-12 AND 15-16 UNDER 35 U.S.C. § 103**

Claims 3, 4, 10 to 12 and 15 to 16 stand rejected under 35 U.S.C. § 103 as being obvious over Janky. It is respectfully submitted that Janky does not render these claims obvious for at least the following reasons.

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must describe or suggest each claim element and it must also provide a motivation or suggestion for modifying the elements in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Accordingly, even if it were proper to modify the Janky reference as suggested (which is not conceded), it is respectfully submitted that the suggestions cited in the Office Action, including, for example, the suggestion cited on page 3 of the Office Action that “[a]n input apparatus having a plurality of operating elements was well known in the art”, do not render claim 17 obvious, or any claims that depend from claim 17, including, claims 4, 10 to 12 and 15 to 16, or claim 3 which depends from claim 2 which recites features essentially analogous to claim 17, for at least the reason that the Janky does not disclose all of the limitations of claim 17, in particular, the limitations of a processor for decoding the multimedia data files, which includes an element for displaying directories located in a storage device and in which the multimedia data files are contained, as different data carriers. It is therefore respectfully submitted that claims 3, 4, 10 to 12 and 15 to 16 are allowable for at least the same reasons that claim 17 is allowable.

Moreover, the Office Action's assertions with respect to a motivation to modify Janky, including, for example, the Office Action's assertion in connection with claim

3 that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Janky by providing a plurality of control elements to enable efficient operation and manipulation of the audio data files” is mere hindsight reasoning for at least the reason that the alleged motivation is simply not found in the Janky. Similarly, the alleged motivation asserted by the Office Action in connection with claims 4, 10 to 12 and 15 to 16 are likewise not found in Janky.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that a subjective “obvious to try” standard is not proper. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted). In short, there must be evidence of why a person having ordinary skill in the art would be motivated to modify a reference to provide the claimed subject matter of the claims.

Still further, it is respectfully submitted that a *prima facie* case of obviousness has not been made in the present case, since the Office Action never made any findings, such as, for example, regarding what the ordinary skill level in the art would have been at the time the claimed subject matter of the present application was made. (See In re Rouffet, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the factual predicates underlying a *prima facie* obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art)). It is respectfully submitted that the proper test for showing obviousness is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art, and that the Patent Office must provide particular findings in this regard — the evidence for which does not include broad conclusory statements standing alone. (See In re Kotzab, 55 U.S.P.Q. 2d

1313, 1317 (Fed. Cir. 2000) (citing In re Dembiczak, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made concerning the identification of the relevant art, the level of ordinary skill in the art or the nature of the problem to be solved))). It is again respectfully submitted that there has been no such showing by the Office Action.

In fact, it is again respectfully submitted that the lack of any of the required factual findings in the Office Action forces Applicants to resort to unwarranted speculation to ascertain exactly what facts underly the present rejections. The law requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing In re Warner, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Office has failed to carry the initial burden of presenting a proper prima facie case of obviousness. (See In re Oetiker, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

Accordingly, for at least these reasons, it is respectfully submitted that Janky does not render claims 3, 4, 10 to 12 and 15 to 16 obvious. Withdrawal of these rejections is therefore respectfully requested.

#### IV. CONCLUSION

Each of the issues raised by the Examiner has been addressed. It is respectfully submitted that the present application is in condition for allowance. Passage to issuance is requested.

Respectfully submitted,

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